

**REMARKS**

**Summary of the Office Action**

Claims 24 and 25 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Sato (U.S. Patent No. 6,914,691).

Claims 2-4 and 9-22 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sato in view of Takaoka (U.S. Patent No. 6,137,905).

Claim 5 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sato in view of Takaoka, and further in view of Microsoft Windows NT/95/98.

Claims 6-8 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sato in view of Takaoka, and further in view of Kadowaki (U.S. Patent No. 6,813,038).

Claim 22 stands rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

**Summary of the Response to the Office Action**

Applicants amended claims 2-16, 19, and 22 to further define the invention. Applicants canceled claims 20, 21, 24, and 25, and added new claims 26-28. Accordingly, claims 2-19, 22, and 26-28 are pending for consideration.

**Withdrawal of Finality**

Claim 22 stands rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Applicants respectfully assert that a new ground of rejection NOT necessitated by the Applicants' amendment has been applied. Specifically, Applicants respectfully assert that, prior to the present Amendment, claim 22 has never been amended.

Accordingly, the new grounds of rejection 35 U.S.C. § 101 was not precipitated by any previous amendments to claim 22. Thus, Applicants respectfully assert that the finality of the Office Action issued August 9, 2006 should be withdrawn.

**All Claims Define Statutory Subject Matter**

Claim 22 stands rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. In particular, the Office Action suggests that a program claimed in claim 22 is merely a set of instructions per se, and therefore is directed to non-statutory subject matter. Applicants respectfully disagree.

Applicants respectfully assert that the preamble of claim 22, as originally filed and unamended to date recites, in part, “a computer-readable storage medium that stores a program for commanding a computer for image processing.” Accordingly, claim 22 is directed to a computer readable storage medium and not directed to a program per se. As pointed out in MPEP § 2106 IV.B.1.(a), “[W]hen a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim.” Therefore, Applicants respectfully assert that claim 22 explicitly recites statutory subject matter, and assert that the rejection of claim 22 under 35 U.S.C. § 101 should be withdrawn.

**All Claims Define Allowable Subject Matter**

Claims 24 and 25 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Sato (U.S. Patent No. 6,914,691). While Applicants respectfully traverse this rejection, Applicants cancel claims 24 and 25 to advance prosecution of the present application.

Claims 2-4 and 9-22 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sato in view of Takaoka (U.S. Patent No. 6,137,905). Applicants respectfully disagree.

The Final Office Action acknowledges that Sato fails to disclose the features claimed in independent claim 2. Applicants respectfully assert that Takaoka fails to teach the features recited by amended claim 1. Independent claim 2, as amended, recites “a recognition unit that recognizes whether the specific image *to be prohibited from outputting* exists in the input image data.” In addition, claim 2 further recites “a determination unit that determines whether the input image data *meets a condition indicating the input image data includes the specific image*, and controls the recognition unit not to recognize the specific image if *the input image data meets the condition*, and an output image data generation unit that outputs an output image data *corresponding to the input image data which is not recognized by the recognition unit*,” (emphasis added). Applicants respectfully assert that Takaoka is silent as to this combination of features.

The Final Office Action relies upon Takaoka for allegedly teaching a “determination unit (character recognition/orientation discrimination unit, See Figure 1, Element 13).” Applicants respectfully assert that the portions of Takaoka cited in the Final Office Action refer to the recognition unit. Thus, Applicants respectfully assert that Takaoka only discloses a recognition unit and fails to teach or suggest a “determination unit,” as explicitly recited by claim 2. In addition, Applicants respectfully assert that Takaoka is silent as to a process for determining whether the input image data meets a condition indicating the input image data includes the

specific image, and controlling the recognition unit not to recognize the specific image if the input image data meets the condition. Furthermore, Applicants respectfully assert that Takaoka is silent as to the recognition unit recognizing “*whether a specific image to be prohibited from outputting exists* in the input image data,” (emphasis added). Takaoka merely discloses (col. 13, lines 17-23 and col. 14, lines 41-48) that the recognition of a character area enables the discrimination of orientation. Thus, Element 13 of FIG. 1 of Takaoka is explicitly referred to and designated by Takaoka as a recognition unit/orientation discrimination unit. Applicants respectfully assert that a recognition process is not performed by comparing the input image data with a specific image. Accordingly, Applicants respectfully assert that independent claim 2, as amended, is allowable over Takaoka. Moreover, Applicants respectfully submit that independent claim 9, 19, and 22 are also allowable for reasons similar to those presented above with regard to amended independent claim 2.

Applicants respectfully assert that the rejection of independent claims 2, 9, 19, and 22 and dependent claims 3-8 and 10-18 under 35 U.S.C. § 103 should be withdrawn because Sato and Takaoka either taken singly or in combination, fail to teach or suggest the combination of features recited by claims 2, 9, 19, and 22, and thus, dependent claims 3-8 and 10-18. As pointed out in MPEP § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). Therefore, Applicants respectfully assert that claims 2-19 and 22 should be allowed.

**New Claims 26-28**

Applicants have added new claims 26-28 to further define the invention. Applicant respectfully submits that new claims 26-28 are allowable at least because of the combination of features recited therein.

**CONCLUSION**


In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under

37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully Submitted,

**MORGAN, LEWIS & BOCKIUS LLP**

By:   
David B. Hardy  
Reg. No. 47,362

Dated: December 7, 2006

**MORGAN, LEWIS & BOCKIUS LLP**

1111 Pennsylvania Avenue, N.W.

Washington, DC 20004

Tel.: 202.739.3000

Fax: 202.739.3001